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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number: 10569-002001
I hereby certify under 37 CFR §1.8(a) that this correspondence is being transmitted by facsimile to the Patent and Trademark Office on the date indicated below. <u>May 15, 2006</u> Date of Deposit Signature <u>Tammara A. Shinn</u> Typed or Printed Name of Person Signing Certificate	Application Number 09/281,396	Filed March 30, 1999
	First Named Inventor Dale Pelletier	
	Art Unit 2645	Examiner Simon P. Sing
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record <u>44,109</u> (Reg. No.)</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p>		
<p><input checked="" type="checkbox"/> Total of 1 forms are submitted.</p>		

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Attorney's Docket No.: 10569-002001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Dale Pelletier
Serial No. : 09/281,396
Filed : March 30, 1999
Title : TELEPHONE SET

Art Unit : 2645
Examiner : Simon P. Sing

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Panel review is required because the rejections here are based on plain legal errors. We address one primary error below that applies to all of the pending claims. Claims 1-34 are pending; claims 1, 18, 19, and 20 are the independent claims. The claims have been rejected as obvious in light of Japanese patent 5-22428 to Sakayori et al., in view of various other references, or over U.S. Patent 6,405,032 to Buhmann, in view of two other references. No rejection employs fewer than three references. We discuss the references only to the extent necessary here.

Brief Introduction to the Technology and Prior Art

The pending application relates to telephone sets and telephone systems. In general, the inventions make operation of a telephone more intuitive by integrating a message retrieval key with a message waiting light. Thus, a user of the telephone, to recover messages, need merely press the light, and need not hunt around.

The assignee of the instant application develops and sells telephone sets to the hospitality industry—i.e., hotel telephones. The inventions can be well-understood in that context. With such telephones, a hotel guest is typically unfamiliar with the particular telephone in a room, and the room is often dimly lit when the user enters. In addition, hotel telephones often have a number of labeled speed dial buttons for various services, such as wake-up calls, maid service,

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and the like. Thus, the guest, upon seeing a blinking message waiting light, will have to hunt around for the appropriate dialing key. The integrated device allows the user to find the right key intuitively—a real benefit. This innovation has now been implemented by a number of makers of hotel telephones, as demonstrated in the Applicant's response of September 26, 2005.

Importantly, the pending claims do not simply recite an integrated message retrieval device and message waiting light. Rather, they also recite, in various manners, that the integrated structure is to be located separate and apart from the telephone dialing grid (e.g., claim 1). This feature provides multiple benefits. First, it makes the integrated key stand out from the other keys—consistently with the entire point of making the key easier for an unfamiliar user to find. Second, it allows telephones on which the integrated key is installed to use a standard dialing pad—no special modification of the pad is needed to accommodate the inventions. As a result, the inventions can be integrated more readily into a company's existing telephones and existing product lines. Other claims additionally recite that the integrated device is to be substantially larger than each of the dialing keys (claim 8), is to have a shape that is different from that of the dialing keys (claims 18 and 20), and is larger than *and* shaped differently than the dialing keys (claim 19).

Legal Error #1: Wholly Ignoring the Requirement that the Integrated Key be Located Away from the Dialing Grid

It is plain legal error to read a feature entirely out of a claim, or to ignore a feature positively recited in a claim. *See Pause Technology LLC v. Tivo Inc.*, Docket No. 04-1263, at 15-16 (Fed. Cir. Aug. 16, 2005) (rejecting claim construction that would ignore claim term “predetermine”); *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1105 (Fed. Cir. 1996) (refusing to adopt a claim construction that would ignore a claim limitation); *Texas Instruments Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1171 (Fed. Cir. 1993) (“[T]o construe the claims in the manner suggested by TI would read an express limitation out of the claims. This we will not do....”).

The examiner here has improperly read out of the pending claims the requirements that the integrated key be located away from the grid of dialing keys. This is an important limitation because, consistent with the entire point of the features, it sets the integrated key apart visually in

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multiple ways, and thus make it easier for unfamiliar users to use the telephone. It is plain legal error for the examiner to wholly ignore these limitations.

Moreover, Applicant added this feature to the claims after the examiner's non-final Office Action, and emphasized the importance of the feature. Yet the Final Office Action, even though it has a separate section purporting to respond to Applicant's arguments, says nothing about the requirement that the integrated key be outside the dialing grid. This is plain error.

Legal Error #2: Wholly Ignoring Objective Evidence of Nonobviousness

In responding to the non-final Office Action, Applicant pointed to a number of competing telephone systems that now feature the invention covered by one or more of the pending claims. The Applicant also pointed out that such commercial success and standardization of the inventions is compelling evidence of nonobviousness, citing *In re Hayes Microcomputer Products, Inc. Patent Litigation*, 982 F.2d 1527 (Fed. Cir. 1992) ("[T]he commercial success of the invention, the failure of others to solve the problem addressed by the patented invention, and the fact that [an embodiment of the invention] has become the industry standard is **compelling objective evidence of the nonobviousness** of the claimed invention." (emphasis added)).

The examiner, however, never addressed this evidence in making the obviousness rejections here – again, a plain legal error, as the Federal Circuit has made clear that objective evidence must be considered when it is present.

Please charge Deposit Account No. 06-1050 in the amount of \$225 for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.


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Respectfully submitted,

Date:

May 15, 2006


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